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Docket No. JAB-1281DIV1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Jean-Paul Rene Marie Andre Bosmans et al. Confirmation No.: 5454
Appln. No. : 10/643,506
Filed : August 19, 2003
Title : BICYCLIC BENZAMIDES OF 3-OR 4-SUBSTITUTED 4-
(AMINOMETHYL)-PIPERIDINE DERIVATIVES

Art Unit : 1625
Examiner : Celia C. Chang

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October 27, 2004

(Date of Deposit)

Ellen Ciambrone Coletti

(Name of applicant, assignee, or Registered Representative)



(Signature)

October 27, 2004

(Date of Signature)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Dear Sir:

This is in response to the Office Action mailed September 27, 2004 in the captioned application.

In the Office Action, it is stated that claims 1-12 are in the case. Applicants note that Claim 13 was added by preliminary amendment dated August 19, 2003. Clarification is requested.

In the Office Action, restriction is required to one of the following under 35 USC 121:

- I. Claim 6, drawn to L is nonheterocyclic moieties, R1-R2 forms benzofuranyl ring. If this group is elected, generic claims, 1-5, 7-9, 11 can be prosecuted together with the elected compounds.

- II. Claim 5 in part, drawn to L is dioxolane or tetrahydropyranyl. If this group is elected, generic claims 1-5, 7-9, 11 can be prosecuted together with the elected compounds.
- III. Claims 1-5,8-9,11, drawn to remaining compounds. The classification can only be determined upon election of a single disclosed species for which the remaining compound will be accessed. Further restriction based on the species will be made.
- IV. Claims 10 and 12, drawn to piperidinyl benzofused ring compounds. If this group is elected, a further election of a single disclosed species is also required. Further restriction based on the species election may be required.

Applicants hereby elect with traverse the subject matter of Group I, that is, claim 6, drawn to L is nonheterocyclic moieties, R1-R2 forms benzofuranyl ring, and generic claims 1-5, 7-9 and 11. Applicants direct attention to parent US Patent 6,635,643.

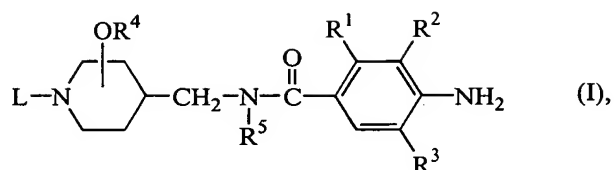
Applicants respectfully submit that the restriction requirement is inappropriate.

Applicants direct attention to MPEP Section 803.02 which states in part, that:

Since the decisions in *In re Weber*, 580 F. 2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F. 2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In *re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. (emphasis added)

Applicants submit that unity of invention exists for the members of the Markush group herein in that they (1) share a common utility – treating conditions involving a decreased gastrointestinal motility and (2) share a substantial structural feature disclosed as being essential to that utility that is

Serial No. 10/643,506



Based on the foregoing, Applicants submit that the Restriction Requirement is improper and should be withdrawn.

Applicants respectfully request examination of the captioned application and allowance of same.

Respectfully submitted,



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